

## REMARKS

Upon entry of the foregoing Amendment, claims 1-41 are pending in the application. Claims 1-41 have been amended. Claims 42-55 have been cancelled. No claims have been newly added. Applicant believes that this Amendment does not add new matter. In view of the foregoing Amendment and the following Remarks, allowance of all the pending claims is requested.

### NON-STATUTORY DOUBLE PATENTING REJECTION

The Examiner has provisionally rejected claims 1-37 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-56 of co-pending Application No. 09/877,926.

Applicant will consider filing a terminal disclaimer to overcome this rejection once otherwise patentable subject matter has been determined. Furthermore, Applicant notes that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting does not constitute an admission of the propriety of the rejection. *See Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870 (Fed. Cir. 1991).

### REJECTION UNDER 35 U.S.C. § 101

The Examiner has rejected claims 39-41 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Examiner alleges that the "claims do not provide any transformation nor do they have any other statutory class in the body of the claim." Solely for purposes of expediting prosecution of this application, and without acknowledging the propriety of the alleged basis for the rejection, Applicant notes that claims 39-41 have been amended as indicated above to further clarify the invention.

Accordingly, for at least the reason that amended claims 39-41 recite various features that relate to another statutory class (e.g., "enabling the client to submit personal and financial data to the electronic collaboration tool, wherein the personal and financial data submitted to the electronic collaboration tool is stored in one or more databases coupled to the information

processing hub”), claims 39-41 are directed to statutory subject matter. For at least this reason, the rejection is improper and should be withdrawn.

**REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

The Examiner has rejected claims 1-41 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner alleges that “there is no clear definition of the meets [*sic*] and bounds” for the following claim terms: “collaborate,” “enabling,” “to interact,” “events,” and “actions.” In addition, The Examiner further alleges that the “terms ‘clients’ and ‘participants’ are confusing since the relationship between the two is not recited,” and that claims 20-38 are indefinite because a “system” is “vague and indefinite since a system may be one of several statutory classes of invention.”

Although Applicant disagrees with the propriety of this rejection for *at least* the reasons previously set forth in the Appeal Brief filed January 11, 2007, solely in an effort to expedite prosecution of this application, Applicant has amended claims 1041 as indicated above to further clarify the invention. Accordingly, for at least the reason that amended claims 1-41 particularly point out and distinctly claim the subject matter which Applicant regards as the invention, Applicant requests that the Examiner withdraw this rejection of the claims.

**REJECTION UNDER 35 U.S.C. § 103**

**A. CLAIMS 1-7, 9-17, 19-26, 28-36, AND 38-40**

The Examiner has rejected claims 1-7, 9-17, 19-26, 28-36, and 38-40 under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent No. 5,940,843 to Zucknovich (“Zucknovich”). This rejection is improper and should be withdrawn for at least the reason that Zucknovich fails to disclose, teach, or suggest each and every feature of the claimed invention.

More particularly, Zucknovich does not disclose, teach, or suggest at least the feature of “enabling the financial services provider participants to provide the requested services for the financial services client through the electronic collaboration tool, wherein enabling the financial services provider participants to provide the requested services includes enabling

interaction among the financial services client and the financial services provider participants and further enabling interaction among the authorized participants, wherein the enabled interaction includes an exchange of the client data stored in the one or more databases," as recited in independent claim 1, for example.

The Examiner appears to rely upon col. 5, lines 60-67 of Zucknovich as allegedly teaching the claimed "client" and "client data," and col. 7, lines 14-50 and col. 8, lines 14-50 as allegedly teaching the claimed "interaction among the financial services client and the financial services provider participants and . . . interaction among the authorized participants, , wherein the enabled interaction includes an exchange of the client data stored in the one or more databases." However, Zucknovich is fundamentally different, and addresses different problems from those of the claimed invention. In particular, Zucknovich generally relates to distributing reports generated by research contributors to investors, which does not relate to an electronic collaboration tool that enables one or more service providers to provide requested services for a client using data associated with the client.

For example, the research reports in Zucknovich, as identified by the Examiner, cannot be considered reasonably analogous to "client data," as the claimed invention specifically recites enabling collaboration between clients and participants by authorizing participants to access "client data." In other words, the "client data" recited in independent claim 1 is specific to the client, and participants may be granted authorization to access the client data in order to provide requested services on behalf of the client. Even assuming *arguendo* that the research contributors and investors described in Zucknovich are similar to the claimed "clients" and "participants" (which Applicant does not concede, the content of the research reports described in Zucknovich concerns third parties rather than the research contributors or investors. As such, because the content of the reports do not describe either of the research contributors or the recipients of the report, the distribution of reports cannot be reasonably considered "an exchange of the client data stored in the one or more databases," as recited in independent claim 1, for example.

This distinction is clear from the Background of Zucknovich, which describes third party financial research firms, which deliver information regarding public companies to investors.

That is, the content of the research pertains to third parties, and thus the distribution and regulation of access is not "an exchange of the client data," which the claimed invention recites as being "related to one or more services provided for the financial services client through the electronic collaboration tool." Rather, Zucknovich merely describes an investor logging into a web site to download research reports, which does not include any "interaction" among the investors, the research contributors, or other parties. Zucknovich describes research contributors independently generating research reports and submitting the reports to a central repository (e.g., col. 5, lines 59-65), but the reports are generated independently of any specific client investor, and the contributor's role is complete once the report is submitted to the repository. Moreover, although investors subsequently log into the web site to download the reports (e.g., col. 7, lines 48-61), downloading a report is not the equivalent of interaction among a client and various service providers or other advisors of the client.

Accordingly, for at least the foregoing reasons, Zucknovich does not disclose, teach, or suggest each and every feature recited in independent claim 1. For at least this reason, the rejection is improper and should be withdrawn.

Independent claims 11, 20, 30, and 39 include features similar to those set forth in independent claim 1. Claims 2-7, 9-10, 12-17, 19, 21-26, 28-29, 31-36, 38, and 40 depend from and add features to one of independent claims 1, 11, 20, 30, and 39. Thus, the rejection of these claims is likewise improper and should be withdrawn for at least the same reasons.

In addition, the Examiner has failed to establish that Zucknovich qualifies as analogous art. More particularly, "in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992).

Zucknovich's field of endeavor relates to research providers electronically distributing opinions and reports to recipients (col. 1, lines 5-10). In contrast, the field of endeavor for the claimed invention relates to the provision of client-specific services and advice through enabling collaboration among clients and their advisors or other service provider participants. Furthermore, the particular problem addressed by Zucknovich relates to enabling research

providers to control access to their opinions and reports, or to indicate that a company is under review (col. 1, line 39 – col. 2, line 14), whereas the particular problem that the claimed invention addresses relates to enabling an exchange of client data among various authorized entities, thereby providing consistent, accurate, and secure collaboration using client data, shared resources, and/or other information.

In response to previous arguments addressing this issue, the Examiner responded by alleging that Zucknovich “is both in the field of applicant’s endeavor and is reasonable [sic] pertinent to the particular problem with which the applicant is concerned.” The Examiner’s allegation is broad and conclusory, and lacks any evidence or other support for the allegation that Zucknovich is in Applicant’s field of endeavor and/or reasonably pertinent to the problem addressed by Applicant.

Accordingly, for at least the foregoing reasons, Zucknovich is neither in Applicant’s field of endeavor nor reasonably pertinent to the particular problem with which Applicant was concerned. As such, the Examiner has failed to establish that Zucknovich qualifies as analogous art that can be used in an obviousness rejection, and each obviousness rejection based thereon must fail for at least this reason.

**B. CLAIMS 8, 18, 27, 37, AND 41**

The Examiner has rejected claims 8, 18, 27, 37, and 41 under 35 U.S.C. § 103 as allegedly being unpatentable over Zucknovich in view of U.S. Patent No. 6,243,722 to Day et al. (“Day”). This rejection is improper and should be withdrawn for at least the reason that the references relied upon, either alone or in combination, fail to disclose, teach, or suggest each and every feature of the claimed invention.

More particularly, for at least the reasons discussed above, Zucknovich does not disclose, teach, or suggest at least the feature of “enabling the financial services provider participants to provide the requested services for the financial services client through the electronic collaboration tool, wherein enabling the financial services provider participants to provide the requested services includes enabling interaction among the financial services client and the financial services provider participants and further enabling interaction among the

authorized participants, wherein the enabled interaction includes an exchange of the client data stored in the one or more databases," as recited in independent claim 1, for example. Day fails to cure at least this deficiency of Zucknovich.

Accordingly, for at least the foregoing reasons, Zucknovich and Day, either alone or in combination, fail to disclose, teach, or suggest each and every feature of independent claim 1. Independent claims 11, 20, 30, and 39 include features similar to those set forth in independent claim 1. Claims 8, 18, 27, 37, and 41 depend from and add features to one of independent claims 1, 11, 20, 30, and 39. Thus, the rejection of these claims is improper and should be withdrawn for at least the foregoing reasons. In addition, for at least the reasons discussed above, the Examiner has failed to establish that Zucknovich qualifies as analogous art. As such, each obviousness rejection based thereon must fail for at least this reason.

Furthermore, Day also fails to qualify as analogous art. For example, even assuming *arguendo* that the Examiner correctly characterized Day as being "concerned with network based document (information) review tools via a computer network," merely being concerned with viewing documents over a network does not bring Day with Applicant's field of endeavor, which relates to the provision of client-specific services and advice through enabling collaboration among clients and their advisors or other service provider participants. Viewing documents over a network also does not address the particular problem addressed by Applicant's claimed invention (i.e., enabling an exchange of client data among various authorized entities to provide consistent, accurate, and secure collaboration using client data and other information).

Accordingly, for at least the foregoing reasons, Day is neither in Applicant's field of endeavor nor reasonably pertinent to the particular problem with which Applicant was concerned. As such, each obviousness rejection based on Day must fail for at least this additional reason.

## CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action. As such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Respectfully submitted,

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